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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,650	12/20/2001	Gregory T. Newman	45,024	5097

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EXAMINER

COHEN, AMY R

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/029,650	NEWMAN, GREGORY T.
	Examiner	Art Unit
	Amy R Cohen	2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 15 January 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-8 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- 1) Certified copies of the priority documents have been received.
- 2) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- 3) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandimarte (U. S. Patent No. 4,648,185) in view of Miller (U. S. Patent No. 6,421,928).

Brandimarte discloses a leveling and marking tool (10) for mounting an item having pre-cut mounting holes to a wall, and for making indenting marks in the wall that are in spaced apart relation to match the pre-cut mounting holes of the item to be mounted (Col 2, lines 8-21), the leveling tool comprising: a frame (12) having a front surface, a back surface (Figs. 1, 3, and 4), a lengthwise opening (14), a first projected tab (28) mounted in a fixed hole (30) at an end of the frame on the same axis as the lengthwise opening (Fig. 1), a second projected tab (18) movable in an axial direction along the lengthwise opening (Col 2, lines 8-21), threadable locking means (22) for fixing the second projected tab in selected locations along the lengthwise opening spaced longitudinally from the first projected tab at a distance corresponding to the distance between the pre-cut mounting holes, at least one bubble gauge (36, 40) mounted to the frame, and means associated with the first projecting tab and the second projected tab for accurately indenting said marks in the wall (Col 2, lines 15-21).

Brandimarte discloses the leveling and marking tool wherein the frame includes a printed reference scale (20) with the fixed hole serving as a zero point on the printed reference scale (Col 2, lines 23-30).

Brandomarte discloses the leveling and marking tool wherein the locking means includes threads and passes through a longitudinal slot in the frame and wherein said fixed hole is a threaded hole (Col 2, lines 8-21).

Brandomarte does not disclose the leveling and marking tool wherein the first and second projected tabs each have a conical point that outwardly projects from the back surface of the frame at an equal distance from the back surface of the frame, wherein the means for indenting the marks in the wall is performed by placing the back surface of the frame against the wall with the conical points of the first projected tab and the second projected tab in slight contact with the wall, aligning the frame against the wall, and firmly pressing the frame against the wall so that the said conical points firmly impact the wall, and wherein the conical point of the first projected tab and the conical point on the second projected tab are 45 degree cone shaped points.

Miller discloses a leveling and marking tool (10) wherein the first and second projected tabs each have a conical point (36, 37, 66) that outwardly projects from the back surface of the frame at an equal distance from the back surface of the frame (Col 6, lines 18-49), wherein the means for indenting the marks in the wall is performed by placing the back surface of the frame against the wall with the conical points of the first projected tab and the second projected tab in slight contact with the wall (Col 7, lines 45-51), aligning the frame against the wall, and firmly pressing the frame against the wall so that the said conical points firmly impact the wall (Col 7, lines 45-51).

Regarding the specific angle of the coned shaped points: Miller discloses a coned shaped point (36, 37) where the degree of the coned shaped points is not specifically stated. However, to choose a 45 degree coned shaped point of the conical points, absent any criticality, is only considered to be the “optimum” value of the coned shaped points, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation

based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

It would have been obvious to one of ordinary skill in the art to modify the leveling and marking tool of Brandimarte to include conical shaped points outwardly projecting from the tabs, as taught by Miller, so that a marking device as already taught by Brandimarte (Col 2, lines 19-21) would be permanently fixed to the tabs, so that a user could mark a wall without a pen or pencil.

#### *Response to Arguments*

3. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

#### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patent also discloses a leveling and marking tool Gier (U. S. Patent No. 6,473,983).

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R Cohen whose telephone number is (703) 305-4972. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3431.

ARC  
March 10, 2003

  
Diego Gutierrez  
Supervisory Examiner  
Tech Center 2800